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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/644,217

08/20/2003

Yoshinori Yamagishi

03-542

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EXAMINER

IP, SIKYIN

ART UNIT

PAPER NUMBER

1793

MAIL DATE

DELIVERY MODE

01/02/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/644,217

Applicant(s)

YAMAGISHI ET AL.

Examiner

Sikyln Ip

Art Unit

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

There is no literal support for amended "0.5 wt.% of tin" and alpha phase "90 vol% or more". The expression "or more" includes vol% that does not disclose by specification as originally filed.

Claim Rejections - 35 USC § 103

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1 and 5 are rejected under 35 U.S.C. § 103 as being unpatentable over JP 60194035.

JP 60194035 discloses the features including the claimed Cu-Zn alloy composition and alpha-phase structure (abstract and Table 1, No. 1, 3, and 8). Therefore, when prior art compounds essentially "bracketing" the claimed compounds in structural similarity are all known, one of ordinary skill in the art would clearly be motivated to make those claimed compounds in searching for new products in the expectation that compounds similar in structure will have similar properties. In re Gyurik, 596 F.2d 1012, 1018, 201 USPQ 552, 557 (CCPA 1979); See In re May, 574 F.2d 1082, 1094, 197 USPQ 601, 611 (CCPA 1978) and In re Hoch, 57 CCPA 1292, 1296, 428 F.2d 1341, 1344, 166 USPQ 406, 409 (1970). As stated in In re Peterson, 315 F.3d 1325, 1329-30, 65 USPQ2d 1379, 1382 (Fed. Cir. 2003), that "A prima facie case of obviousness typically exists when the ranges of a claimed composition overlap the ranges disclosed in the prior art". Therefore, it would have been obvious to one of ordinary skill in the art to select any portion of range, including the claimed range, from the broader range disclosed in a prior art reference because the prior art reference finds

that the prior art composition in the entire disclosed range has a suitable utility. Also see MPEP § 2131.03 and § 2123.

With respect to the instant recited expressions in claim 5 that it is well settled that there is no invention in the discovery of a general formula if it covers a composition described in the prior art, *In re Cooper and Foley* 1943 C.D. 357, 553 O.G. 177; 57 USPQ 117, *Taklatwalla v. Marburg*, 620 O.G. 685, 1949 C.D. 77, and *In re Pilling*, 403 O.G. 513, 44 F(2) 878, 1931 C.D. 75. In the absence of evidence to the contrary, the selection of the proportions of elements would appear to require no more than routine investigation by those ordinary skilled in the art. *In re Austin, et al.*, 149 USPQ 685, 688.

Response to Arguments

Applicant's declaration and arguments filed October 16, 2007 have been fully considered but they are not persuasive.

Applicants' argument in paragraph bridging pages 4-5 of instant remarks is noted. But, examples 7 and 20 in instant Table 1 have alpha phase vol% less than 90 (81 and 84 vol% respectively) also have good dezincing resistance and stress corrosion cracking resistance.

Applicants argue that JP 60194035 fails to disclose claimed tin content. Applicants' attention is directed to Table 1, samples no. 1, 3, and 8 of JP 60194035 below.

第1表 試験材料の化学成分

試料	Cu	Pb	Fe	Sn	Zn	Al	Ni	Mn	Sb	P
1	58.82	2.14	0.26	0.29	残部	—	0.10	—	—	—
2	60.07	0.08	0.04	0.75	"	—	—	—	—	—
3	57.39	0.33	0.57	0.19	"	0.72	0.45	0.76	—	—
4	63.58	1.30	0.34	1.33	"	—	0.08	—	—	—
5	63.85	1.82	0.31	0.92	"	—	0.35	—	0.02	0.02
6	63.55	1.99	0.23	1.10	"	—	0.40	—	0.06	0.05
7	64.18	2.33	0.45	0.79	"	—	0.32	—	0.02	0.09
8	59.52	2.04	0.21	0.30	"	—	0.05	—	—	0.12

第 2 表 機械的性質及び被削性					
試料 番号	試料 寸法 mm φ	機 械 的 性 質			ドリル
		引張り強さ kgf/mm ²	伸び %	硬さ HR(B)	テスト値 %
1	15	47.2	33.2	68	74
2	15	44.5	37.6	64	24
3	15	66.5	18.2	81	22
4	15	46.3	33.6	67	62
5	15	46.5	34.2	67	70
6	15	46.8	33.8	68	73
7	15	45.9	32.5	67	76
8	15	46.1	35.7	65	72

一万、第3表は前記各試料の脱亜鉛腐食試験結果を示すものであり、ISO 6509に規定する脱亜鉛腐食試験方法により行つたものである。即ち、暴露試験表面が押し出し方向に対して直角となるように試料をフェノール樹脂に埋め込み、試料表面を1200番まで研磨後バフ仕上げをし、次にその試料を127 g/lの塩化銅水塩 (CuCl₂ · 2H₂O) の水溶液中に浸漬し、75℃で24時間保持した後、試料を取り出し、平均の脱亜鉛腐食深さを測定した。

第3表 脱亜鉛腐食試験結果

試料番号	脱亜鉛腐食深さ (mm)
1	0.95
2	0.31
3	0.46
4	0.06
5	0.04
6	0.02
7	0.03
8	0.35

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Conclusion

The above rejection relies on the reference(s) for all the teachings expressed in the text(s) of the references and/or one of ordinary skill in the metallurgical art would have reasonably understood or implied from the text(s) of the reference(s). To emphasize certain aspect(s) of the prior art, only specific portion(s) of the text(s) have been pointed out. Each reference as a whole should be reviewed in responding to the rejection, since other sections of the same reference and/or various combination of the cited references may be relied on in future rejection(s) in view of amendment(s).

All recited limitations in the instant claims have been met by the rejections as set forth above.

Applicant is reminded that when amendment and/or revision is required, applicant should therefore specifically point out the support for any amendments made to the disclosure. See 37 C.F.R. § 1.121 and 37 C.F.R. Part §41.37 (c)(1)(v).

Examiner Correspondence


Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Ip whose telephone number is (571) 272-1241. The examiner can normally be reached on Monday to Friday from 5:30 A.M. to 2:00 P.M.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Roy V. King, can be reached on (571)-272-1244.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


SIKYIN IP
PRIMARY EXAMINER
ART UNIT 1793

S. Ip
December 25, 2007